

INFORMATION DISCLOSURE STATEMENT

Applicant filed an Information Disclosure Statement on July 23, 2002, prior to the mailing date of the first action on the merits. The documents cited therein were first cited in a communication from a corresponding international application not more than three months from the mailing date of the IDS. It is respectfully requested that the Examiner consider such references and acknowledge the same by initialing next to each reference, signing the PTO-1449 form and returning the same to the Applicant.

PRIOR ART REJECTIONS

Claims 1, 2, 8 and 13 are rejected under 35 U.S.C. §102(b) as being anticipated by Furukawa (JP 5-87760), while the remaining claims 3-7 and 9-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Furukawa in view of Best (U.S. Patent 5,358,259). Responsive thereto, Applicant has amended the claims to clarify a distinction between the claimed invention and the prior art. Specifically, Applicant has amended the claims to provide that the emotional output of the player is dependent on the magnitude of the pressure-sensing signal output. Support for such amendment is clearly found in the originally-filed specification. According to the amended claims of the present invention, it is possible to provide a user interface for exchanges among characters that is more realistic and easier-to-use than selecting items by pushing a simple ON/OFF switch.

Furukawa '760 discloses a cross key 12 that has a conductive portion 33. The pressing force caused by a finger changes the electrical resistance of the conductive portion 33, so that the speed of the character's movement can be changed in response to

the magnitude of the pressing force. Thus, Furukawa '760 merely teaches the translation of a push button on the movement of a game character.

Accordingly, Applicant respectfully disagrees with the Examiner that the claims as amended are taught by Furukawa '760. The Manual For Patenting Examining Procedure (MPEP) § 2131 clearly sets forth the standard for rejecting a claim under 35 U.S.C. § 102(b). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP § 2131, quoting Verdegaal Bros. v. Union Oil Co. of California 2 USPQ2d 1051, 1053 (Fed Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ...claim." (MPEP § 2131, quoting Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). "The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e. identity of terminology is not required." (MPEP § 2131, citing In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990)).

In this case, Furukawa '760 fails to teach the claimed invention as required by the MPEP because Furukawa '760 fails to teach an emotional output that varies with the magnitude of the pressing force. Accordingly, it is respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. § 102(b) in view of Furukawa '760. It should be appreciated that Applicant cannot reasonably claim every variation of the claimed invention and does not make a general disclaimer by this amendment.

With respect to the §103(a) rejection, Best '259 discloses the emotional interaction between characters on a screen and emotional responses to selections by a

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player with a button. The selection of responses is characterized by a simple press of the button or a simple ON/OFF type maneuver.

However, neither Furukawa '760 nor Best '259 teach the variation of an emotional response in relation to the variation or magnitude in pushing pressure on the controller. Best '259 merely teaches the selection of responses without regard to variations in magnitude of pushing pressure. This type (Best '259) of simple selection is discussed in the originally-filed specification on page 1, lines 20-23. Accordingly, Applicant respectfully submits that any rejection of the presently amended claims based on the Furukawa '760 and Best '259 references should be based on improper hindsight, and not on any teaching or suggestion in the references. Neither Furukawa nor Best teach the variation of an emotional response in relation to the magnitude of the pressure-sensing output signal or the changes therein.

Applicant respectfully disagrees with the Examiner that the prior art either alone or in combination teaches or suggests the claimed invention, and Applicant submits that a *prima facie* case of obviousness has not been successfully established.

In order to establish a case of *prima facie* obviousness there must be shown a motivation to combine the teachings of the Furukawa '760 and Best '259 references. To that end, some suggestion of the desirability to combine the references must be found and demonstrated in the references. This burden cannot be satisfied by simply asserting that the modification would have been "well within the ordinary skill of the art."

Applicant submits that there is no suggestion of the desirability to combine the cited art, nor is there any motivation demonstrated in either of the references to combine

them, nor is there any suggestion in the Best '259 reference to adapt the Furukawa '760 structure to the unique construction of the present invention. For instance, the Examiner asserts that "By having different magnitude of output values for different emotions by a pressure-sensitive means, one of ordinary skill in the art would be able to provide [a] realistic interactive game. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Furukawa to include a magnitude of output values for different emotions by a pressure-sensitive means as taught by Best. To do so would be able to provide true to life expressive communication between a game player and the character on the screen." However, as noted above, Best '259 only teaches the selection of emotions using an ON/OFF type switch from a variety of different emotional-type selections. Therefore, one skilled in the art would not benefit at all from the teaching of Best '259 to create a variable emotional response selection from the teaching of Furukawa '760. Accordingly, Applicant submits that there is no teaching, suggestion, or motivation to combine the Furukawa '760 and Best '259 references in the manner suggested by the Examiner, and in a manner that results in the obviousness of the claimed invention as amended.

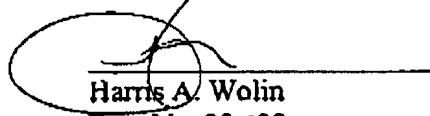
Accordingly, it is respectfully requested that the prior art fails to teach or reasonably suggest a recording medium on which is recorded a computer-readable and executable game software program that includes scenes of exchanges between a player or an on-screen character controlled by the player and other on-screen characters, and that includes a program that performs processing by taking as instructions an output from a controller which has pressure-sensitive means for sensing a magnitude of a pushing

pressure of a player on the controller, wherein said software program comprises a processing program that processes the output of said controller as an emotion of the player, said emotion varying with the pushing pressure magnitude, as claimed, along with a method of executing a game program and a computer as claimed.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1-13, consisting of independent claims 1, 8 and 13 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, he is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,


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MARKED-UP COPY OF AMENDED APPLICATION - 09/757,813IN THE CLAIMS

1. **(AMENDED)** A recording medium on which is recorded a computer-readable and executable game software program that includes scenes of exchanges between a player or an on-screen character controlled by the player and other on-screen characters, and that includes a program that performs processing by taking as instructions an output from a controller which has pressure-sensitive means for sensing a magnitude of a pushing pressure of a player on the controller, wherein

said software program comprises a processing program that processes the output of said controller as an emotion [or volition] of the player, said emotion varying with the pushing pressure magnitude.

2. **(AMENDED)** The recording medium according to claim 1, wherein said processing program processes patterns of changes in the output of said controller as the degree of emotion [or volition] of the player.

8. **(AMENDED)** A method of executing a game program by using a computer that has a controller which has pressure-sensitive means for sensing a pushing pressure of a player on the controller and that is able to execute a game program that includes scenes of exchanges between the player or an on-screen character controlled by the player and on-screen other characters, the method comprising the steps of:

generating a pressure-sensing output signal from said pressure-sensitive means,
said pressure-sensing output signal having a variable magnitude, and
transmitting an emotion [or volition] of the player corresponding to the magnitude
of said pressure-sensing output signal to at least one of said other on-screen characters.

13 (AMENDED) A computer comprising:

a controller which has pressure-sensitive means and that is able to execute a game program that includes scenes of exchanges between a player or an on-screen character controlled by the player and other on-screen characters;

means for generating a pressure-sensing output signal having a variable
magnitude that is indicative of a variable pushing pressure applied by the player on said controller[,] from said pressure-sensitive means, and

means for transmitting an emotion [or volition] of the player corresponding to the
magnitude of said pressure-sensing output signal to said at least one of other on-screen characters.